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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,551	12/10/2003	Robert Salinas		7728

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

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12/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,551

Applicant(s)

SALINAS, ROBERT

Examiner

James W. Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the Response to Pre-Exam Formalities Notice filed on May 17, 2004. Claims 1-31 are currently pending and have been considered below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to presenting an advertisement during a game in which the advertised product may be purchased by the user interacting with the advertisement, classified in class 705, subclass 14.
- II. Claims 13-31, drawn to presenting an advertisement in a game in which the user's interaction with the advertisement modifies one or more parameters of the game, classified in class 705, subclass 14.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as the user may be able to purchase the advertised product without any game parameters being changed. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Kenyon D. Potter on December 17, 2007 a provisional election was made without traverse to prosecute the invention of Group II, claims 13-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

6. Applicant is advised that should claim 23 be found allowable, claim 25 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 25 is directed to a computer system which conducts the same series of steps as method Claim 13. Claim 23 is directed to "A computer system which embodies the method of claim 13". Thus, the two computer systems are equivalent.

Claim Objections

7. Claims 22-24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 22, 23, and 24 are a system claim, computer program claim, and an image claim, respectively that refer back to Claim 13. The Office considers any claim that refers to another claim as dependent thereon, i.e. a dependent claim. Since Claim 13 is a method claim comprising two steps and Claims 22, 23, and 24 fail to add, delete, or change any of these steps, Claims 22-24 fail to further limit their parent claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

(Examiner notes that Claims 10-12 of the withdrawn claims would have the same objections.)

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 23 is directed to a computer program per se. The Office considers a computer program to be non-statutory functional data per se when it is not explicitly recited as being on a computer readable medium. In order to overcome this rejection the Applicant may amend the claim as that it becomes a product claim directed to the computer readable medium, such as "A computer readable medium having a computer stored thereon which when executed by a computer performs a series of steps, comprising:"

Claim 24 is directed to an image generated on a display. The Office considers an image to be non-statutory non-functional data per se.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 13, 18-27, 30, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Koenig (7,054,831).

Claims 13 and 22-27: Koenig discloses a system, method, and program for promoting a product within an electronic game, comprising:

- a. displaying at least one graphical object identifying a promoted product (i.e. an advertisement) (column 3, line 7-37 and column 5, line 46 – column 6, line 17); and
- b. modifying an operational parameter of the electronic game in response to an action being performed by the player (column 3, line 4 7-37 and column 5, line 46 – column 6, line 17).

The Examiner notes that it is inherent that a graphics engine is used to display a graphic object

Claim 18-21: Koenig discloses a method as in Claim 13 above, and further discloses the promoted product is a good or service (column 6, lines 43-44). The Examiner notes

that a contract is an agreement to purchase a good or a service; and, thus, is considered to be included in the disclosure of goods and services. An interest in a real property is also considered to be a good and is likewise included. Furthermore, the type of product being advertised does not affect the steps of displaying the advertisement or modifying the game parameters so it is given little, if any, patentable weight.

Claim 30: Koenig discloses a system as in Claim 25 above, and further discloses the player selecting the promoted product (column 3, lines 7-37 and column 5, line 46 – column 6, line 17).

Claim 31: Koenig discloses a system as in Claim 25, and further discloses the player purchasing the proposed product (column 5, lines 4-5; column 7, lines 56-62; and column 9, line 1-24).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 14-17, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koenig (7,054,831).

Claims 14-17: Koenig discloses a method as in Claim 13 above, and further discloses that “the graphics and plot line of the game are intertwined with the advertisements” (column 8, lines 56-58) and that the player’s interaction will give the player extra clues, increase the speed of the game, awarded points, allowed to advance in the game, etc. While it is not explicitly disclosed that the speed, power, dexterity, or endurance of the player is enhanced, the Examiner notes that these are all game parameters that may or may not be present in the game, depending on the type of game involved. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Koenig to modify whichever game parameter was available and desired in order to award the player for interacting with the advertisement. One would have been motivated to modify the speed, power, dexterity or endurance of the player in view of the disclosure in Koenig that the game may include MYST, DARK FORCES, STREET FIGHTER, etc. in which these parameters play an important part for the player.

Claims 28 and 29: Koenig discloses a system as in Claim 25 above, and further discloses the advertised product being displayed both during the game and after the game play is concluded, but it is not explicitly disclosed displaying the advertisement before the game play begins. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display one or more advertisements to the player before the game begins (e.g. while the game is loading) or after the game play has concluded (e.g. as a banner advertisement on the final score

page. One would have been motivated to display advertisements to the player before, during, and after game play in order to incent the player to purchase more products.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Von Kohorn (5,697,844) discloses a system and method for playing games in which advertisements are embedded with the player required to answer trivia questions about the advertised products in order to win prizes or points in the game.

b. Goldberg et al (5,823,879) discloses a system and method for network gaming which displays targeted advertisements and measures players' responses. The player may select and purchase the advertised product during game play.

c. Miles et al (6,102,406) discloses a system and method for advertising products during an on-line scavenger hunt game based on the advertised products.

d. Keith (6,632,142) discloses a system and method for an internet game in which the player must go to an advertised product website and perform an action such as a pseudo-purchase of the product. The player may also actually purchase the product at the conclusion of the game.

e. Eggleston et al (7,054,830) discloses a system and method for incentive programs in which the odds of winning a prize is determined by the amount of interaction with advertisements about a product.

f. Erlichman (7,112,134) discloses a system and method for playing a photographic game in which the player's use of an image of an advertised product is used to affect the prizes won by the player.

g. Ozaki et al (7,204,753) discloses a system and method for a slot-machine type of game device on which advertisements are displayed.

h. Simmons (US 2005/0020337) discloses a system and method for a trading card game with advertisements incorporated on the backs (or other positions) on the card. The advertisement is used to access online product website from which the player may purchase the product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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JWM
December 19, 2007



James W. Myhre
Primary Patent Examiner